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In re Application of SINGH et al.

Application No.: 10/522,223

PCT No.: PCT/IB03/02962

Int. Filing: 24 July 2003

Priority Date: 25 July 2002

Attorney Docket No.: RLL-255US

For: PROCESSES FOR THE PREPARATION OR ORAL :
DOSAGE FORMULATIONS OF MODAFINIL :

: DECISION ON

: PETITION

: UNDER 37 CFR 1.47(a)

This is a decision on applicant's "Petition Under 37 CFR 1.8(b) and Response to Decision on Petition Under 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 26 October 2006.

BACKGROUND

On 24 January 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 08 August 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 08 March 2006, via facsimile, in response to the Notification of Missing Requirements, applicant apparently filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventors Romi Barat Singh, Pananchukunnath Manoj Kumar, and Vishnubhotla Nagaprasad. This petition is not found among the USPTO records.

On 07 June 2006, applicant filed a supplemental petition under 37 CFR 1.47(a) along with declarations signed by the previously nonsigning inventors. However, applicant did not enclose a complete copy of the 08 March 2006 submission.

On 25 September 2006, a decision dismissing the petition was mailed to applicant indicating that the petition was being considered under 37 CFR 1.8(b). Applicant was advised that the evidence filed with the petition did not satisfy the requirements of 37 CFR 1.8(b) and that the application was abandoned.

On 28 September 2006, a Notification of Abandonment was mailed to applicant indicating that the application was abandoned for failure to respond to the 08 August 2005 Notification of Missing Requirements.

On 26 October 2006, applicant submitted the renewed petition.

DISCUSSION

The petition under 37 CFR 1.47(a) allegedly filed via facsimile on 08 March 2006 is not found in the USPTO records.

37 CFR 1.8(b) states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Applicant has now: (1) informed the Office of the previous mailing of the correspondence promptly after becoming aware that the Office did not receive the items by facsimile on 08 March 2006, (2) supplied complete copies of the previously faxed correspondence; and (3) provided a copy of the sending unit's report confirming transmission on 08 March 2006 with a statement which attests on a personal knowledge basis to the previously timely transmission as required by 37 CFR 1.8(b). Applicants' petition under 37 CFR 1.8(b) is **GRANTED**.

The petition submitted on 08 March 2006 authorized charging any fees associated herewith to applicant's Deposit Account. A five month extension of time is required and will be charged accordingly. The Notification of Abandonment is hereby **VACATED**.

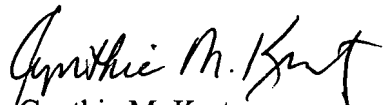
Furthermore, applicant has now submitted the executed declarations of all inventors. A review of the declarations indicate that the requirements of 37 CFR 1.497(a) and (b) have been met. Applicant's petition under 37 CFR 1.47(a) is **DISMISSED as MOOT**.

CONCLUSION

Applicants' petition under 37 CFR 1.8(b) is **GRANTED**. The Notification of Abandonment mailed on 28 September 2006 is hereby **VACATED**. Applicant's petition under 37 CFR 1.47(a) is **DISMISSED as MOOT**.

The application will be forwarded to the United States Designated/Elected Office. The

35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 7 June 2006.



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